

REMARKS

In the Office Action dated August 10, 2005, pending claims 1, 7, and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,231,059 to Pente (“Pente”). Pending claims 20, 22-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,632,268 to Schroeder (“Schroeder”).

35 U.S.C. §102(b) – Pente

Pending claims 1, 7, and 19 stand rejected under §102(b) as being anticipated by Pente. Pente, however, does not disclose each and every limitation of Applicant’s claim 1. In particular, Pente does not disclose wherein the tabs of the back panel section are engageable with the tire to hold the front panel in a predetermined position. In the Office Action, the Examiner “contends that the tabs 8 and 11 of Pente can engage a tire.” The Examiner has failed to show where this contention is disclosed in Pente and has failed to show that it is inherent that the tabs 8 and 11 of Pente are engageable with a tire. According to MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Clearly this is not the present case. The tabs 8 and 11 of Pente being engageable with a tire is neither expressly disclosed nor inherently disclosed in Pente. Accordingly, this rejection should be withdrawn.

Further, the tabs 8 and 11 of Pente are slide tabs that engage each other to hold the two sides together (see the enclosed cut-out of the toy of Pente). The tabs 8 and 11 are completely incapable of engaging a tire as they have already engaged each other to hold the two sides together. Additionally, the Examiner has ignored the remaining limitation of this element, i.e.,

that the tabs are engageable with the tire to hold the front panel in a predetermined position. Even if one were to place the toy of Pente into a tire, the tabs 8 and 11 are not capable of holding the front panel in a predetermined position. The tabs 8 and 11 are incapable of applying enough of a biasing pressure against the tire to hold the front panel in the predetermined position. Applicant, therefore, respectfully requests the Examiner withdraw this rejection and indicate claim 1 as allowable.

As claims 7 and 19 depend, either directly or indirectly, from claim 1 and add additional limitations thereto, the argument above applies equally to those claims. Accordingly, Applicant submits that claims 7 and 19 are allowable and respectfully request the rejection of such be withdrawn.

35 U.S.C. §102(b) – Schroeder

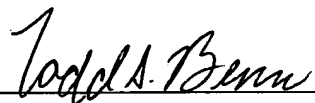
Pending claims 20, 22-24 stand rejected under §102(b) as being anticipated by Schroeder. Schroeder, however, does not disclose or teach each and every limitation of Applicant's independent claims 20 and 22. In particular, Schroeder does not disclose or teach the tabs having at least one edge wherein the edges of at least two of said tabs are coplanar with the edge of the front panel, as required by amended claims 20 and 22. The Office Action contends that "the opposite sides of the tabs 22, 35 and 23, 36 having a portion that is coplanar with the front panel 11 as indicated by arrows below." The arrow, however, points to a portion where the edge of the tabs 22, 35 are actually perpendicular to the edge of the front panel. It appears that the Office Action ignores the requirement of the claims that the edges of the tabs are coplanar with the edge of the front panel. No edge of the tabs 22, 35 and 23, 36 are coplanar with the edge of the front panel. As stated in paragraph [0030] of Applicant's application, the edges of the tabs "are

coplanar with the corresponding edge of the front panel so that the display could fit within a square with sides equal to the diameter of the front panel.” Clearly, therefore, it is important that the edges of the tabs be coplanar with the edge of the front panel. This can also clearly be seen in FIG. 6 of the present application. Accordingly, Applicant respectfully requests the Examiner withdraw these rejections and indicate claims 20 and 22 as allowable.

As claims 23 and 24 depend, either directly or indirectly, from claim 22 and add additional limitations thereto, the argument above applies equally to those claims. Accordingly, Applicant submits that claims 22 and 23 are allowable and respectfully request the rejection of such be withdrawn.

In light of the foregoing, Applicant submits that the application is in condition for allowance.

Respectfully submitted,



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